

REMARKS

The Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 12-63 have been previously withdrawn and are currently canceled.

Claims 1, 3, 6, and 8-10 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-11 (11 claims) are now pending in this application.

A telephonic interview was held on August 30, 2006 with Examiner Michael J. Kyle, Mr. Bruce Polzin (one of the inventors) and the undersigned attorney for the Applicants. The office action of June 6, 2006, the cited prior art, and the Applicants' proposed remarks were discussed. Although an agreement on the claims was not reached in the interview, this Amendment reflects the substance of the interview and the Applicants' position with respect to the several rejections.

On pages 2-4, paragraphs 2-10, the Examiner has rejected claims 1-11 under 35 U.S.C. § 103(a) as being unpatentable over Rechelbacher (USPN: 6,647,582) in view of Kendall (USPN: 5,775,233)

The Applicants submit that Rechelbacher discloses two different types of materials that comprise his grip 20. There is no indication, suggestion or teaching in Rechelbacher that the two different types of materials are used as a mixture.

In contrast, the present application overmold 20 is composed of a single mixture of elastomeric material 21 and foaming agent 23. The two materials are heated and melted in the injection molding machine thereby forming a homogeneous mixture that is injected into the mold cavity. (See at least paragraphs 0037- 0039 of the present application as originally filed.) In the present application, as disclosed and claimed, the foam layer 26 is composed of the same elastomeric material and foaming agent as the enveloping layers 22, 24 but the middle layer, the foam layer 26, is affected by the foaming agent 23 which forms the microcellular structure, without a chemical change, of the foam layer 26. Therefore, the Applicants submit that the apparatus to cushion and dampen vibration disclosed and claimed in the present application, is structurally different from that which is disclosed in Rechelbacher since Rechelbacher requires two different types of materials that are not mixed as opposed to the single mixture of material composing the three layers disclosed and claimed in the present application.

An “apparatus” in which an “overmold composed of a mixture of elastomeric material and a foaming agent, comprising a first layer and second layer and, in conjunction with the first layer enveloping a microcellular foam layer as a unitary, separable overmold member” as required by independent claim 1 is not disclosed, taught or suggested by Rechelbacher.

During the above-identified telephonic conference, the clarification of claim 1 was discussed. The Applicants have stated that the designation of “non-foam” for the first and second layer was used to differentiate from the microcellular foam layer that is enveloped by the first and second layer. However, as indicated above, each of the layers, the first layer, second layer and microcellular foam layer (inner layer) contains the mixture of elastomeric material and foaming agent, but that the first layer and second layer do not have the foaming agent activated as discussed in the specification. Therefore, for clarification, the Applicants have amended independent claim 1 by deleting the term “non-foam” for both the first and second layer.

For purposes of consistency, the Applicants have also amended dependent claims 3, 6, and 8-10 to be consistent with independent claim 1 from which these claims depend either directly or indirectly.

Claim 1 is in independent form. Independent claim 1, as amended, now recites a "separable apparatus" comprising "an overmold member composed of a mixture of an elastomeric material and a foaming agent comprising a first layer and a second layer, in conjunction with the first layer, enveloping a micro-cellular foam layer as a unitary, separable overmold member".

The separable apparatus in which an overmold member is a "unitary, separable overmold member" composed of a mixture of an elastomeric material and a foaming agent as required in independent claim 1, as amended, is not disclosed, taught or suggested by Rechelbacher or Kendall alone or in combination. Support for the amendment to independent claim 1 can be found at least in paragraphs 0037-0039 of the present application as originally filed.

Accordingly, the Applicants respectfully request the Examiner withdraw his rejection under 35 U.S.C. § 103(a) of independent claim 1, as amended, and claims 2-11 which depend from independent claim 1, as amended.

On page 4, paragraph 11 of the Office Action, the Examiner has rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Rechelbacher in view of Kendall as applied to claim 1 above and further in view of Watari (USPN: 5,848,555).

Dependent claim 2 depends from independent claim 1, as amended. As previously described, the Applicants have amended independent claim 1 to recite a combination of subject matter the Applicants believe to be allowable.

Accordingly, the Applicants submit that the rejection under 35 U.S.C. § 103(a) have been overcome and dependent claim 2, as it depends from independent claim 1, as amended, is now allowable. See 35 U.S.C. § 112 para. 4. The Applicants respectfully request reconsideration and allowance of dependent claim 2.

The Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

If any extensions of time are needed for timely acceptance of papers submitted herewith, the Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 02-05-06

By James A. Wilke

James A. Wilke
Attorney for the Applicants
Registration No. 34,279

FOLEY & LARDNER LLP
777 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-5306
Telephone: (414) 297-5776
Facsimile: (414) 297-4900